

REMARKS

Initially, Applicants would like to thank Examiner Arnold for the helpful and courteous Interview conducted May 27, 2009, which Applicants believe materially advanced prosecution in this case. The substance of the Interview is reflected in the comments below. Also, in accordance with the Interview, Applicants currently intend to submit a new Rule 132 declaration comparing compositions containing only water, a silicone containing quaternary ammonium groups and a fatty compound (either a liquid fatty alcohol as required by the claims or a solid fatty compound) to further demonstrate and compare the effect resulting from these combinations of ingredients.

Claim 1 has been amended by incorporating subject matter of claims 2, 3, 7, 8 and 10 into it to specify the silicone compound and fatty alcohol required by the claims, as well as the amounts of these compounds in the composition.

Claims 2, 3, 7, 8 and 10 have been canceled.

Claims 4 and 11 have been amended in a non-limiting manner.

Claims 1, 4-6, 9 and 11-48 are currently pending, although claims 44-46 have been withdrawn from consideration. Upon indication of allowable subject matter, Applicants currently intend to seek rejoinder of withdrawn claims as appropriate pursuant to MPEP § 821.04.

The Office Action rejected claims 1-7, 10-14, 17-20, 28-31 and 34-43 under 35 U.S.C. § 103 as obvious over U.S. patent 5,876,705 (“Uchiyama”) in view of U.S. patent 4,390,522 (“Jacquet”), U.S. patent 6,214,326 (“Dupuis”) and U.S. patent 6,224,888 (“Vatter”). In view of the following comments, Applicants respectfully request reconsideration and withdrawal of these rejections.

The claimed invention relates to transparent compositions containing a specified silicone with quaternary ammonium groups and a specified liquid fatty alcohol (that is, a fatty alcohol which is liquid at 25°C and at atmospheric pressure (1 atm)) in specified concentrations. Of particular note, the claimed invention relates to transparent compositions -- thus, combinations of ingredients resulting in non-transparent compositions do not fall within the pending claims. As explained in the Background section of the present application, this unique combination of elements provides, among other things, transparent compositions with good hair conditioning properties despite the fact that such compositions contain liquid fatty alcohol. Such unique compositions are neither taught nor suggested by the applied art. That is, the art upon which the Office Action has relied neither teaches nor suggests the claimed invention, nor would such art lead one of ordinary skill in the art to the claimed invention with a reasonable expectation of success of producing a transparent composition.

The Office Action recognized that Uchiyama does not “expressly teach a composition with the instantly elected species that is transparent.” (Office Action at 7). Nevertheless, the Office Action asserted that Uchiyama discloses “water soluble cationic polymeric conditioning agents produce substantially clear solutions which would read on transparent (column 17, lines 8-15),” and that one of ordinary skill in the art would have been motivated to “make the composition of Uchiyama transparent and produce the instant invention” because “Uchiyama teach that substantially clear compositions as described above...since the same ingredients are used as instantly claimed then the composition is intrinsically transparent.” (Office Action at pages 4 and 8, respectively).

As discussed during the Interview, Applicants respectfully disagree with this interpretation of Uchiyama. Column 17, lines 8-15 relate to the definition of “water-soluble” in the context of the cationic polymer. This text does not relate to transparency of the overall composition. Nowhere does Uchiyama discuss, suggest or enable the production of transparent compositions.

Uchiyama states that any number of fatty compounds, including solid fatty alcohols and other fatty derivatives, are interchangeable and can be added to his compositions interchangeably – that is, Uchiyama does not recognize the significance or result effective nature of adding the specified liquid fatty alcohol. Furthermore, given that Uchiyama does not discuss transparent compositions, Uchiyama could not have provided any motivation to produce a transparent composition (how could Uchiyama motivate production of a composition which is not discussed?).

As demonstrated in the Rule 132 declaration submitted April 30, 2007, the type of fatty compound added to the composition is significant and result effective: the required liquid fatty alcohols result in transparent compositions; other fatty compounds do not.

Uchiyama provides no guidance whatsoever which would lead one of ordinary skill in the art to combine the required ingredients in the required amounts with the reasonable expectation that a transparent composition would result.

Jacquet cannot compensate for Uchiyama’s deficiencies. Jacquet would not have motivated one of ordinary skill in the art to add the required liquid fatty alcohols to Uchiyama’s compositions. Jacquet’s disclosure of alcohols relates to producing “creams.” (See, col. 6, line 67 et seq.). Because “creams” are recognized by those of ordinary skill in

the art as being opaque, not clear, Jacquet teaches adding alcohols to produce opaque compositions, not clear compositions.

Furthermore, Jacquet does not distinguish between different types of fatty alcohols, including solid, liquid, colorless and colored fatty alcohols in his disclosure. Thus, Jacquet did not recognize that the type of fatty alcohol used was a result effective variable, meaning that no motivation would have existed for one of ordinary skill in the art to take pains to select an appropriate fatty alcohol for optimization and use in Uchiyama's compositions. That is, no motivation would have existed to select the required, optimized liquid fatty alcohol from Jacquet's general disclosure of alcohols (used to produce non-clear creams) to use in Uchiyama's compositions.

Dupuis and Vatter also fail to compensate for Uchiyama's fatal deficiencies. Dupuis and Vatter are cited merely for their disclosure of specific compounds. Neither of these references would lead one of ordinary skill in the art to prepare a transparent composition containing, among other ingredients, a liquid fatty alcohol with the expectation that a transparent composition would actually result. The pending § 103 rejection constitutes nothing more than impermissible hindsight, using the present application as a guide, to combine the required elements together in such a way to yield the claimed transparent compositions. In other words, without Applicants' invention, the rejection could not be supported. Such a rejection is improper and should be withdrawn.

Applicants respectfully submit that for at least this reason no *prima facie* case of obviousness has been set forth.

Furthermore, even assuming a *prima facie* case of obviousness has been set forth -- which is not the case -- sufficient evidence of unexpected/surprising results exists to rebut any such hypothetical case of obviousness. More specifically, the previously submitted Rule 132 declaration demonstrates the unexpected/surprising results associated with the claimed compositions. The declaration indicates that the demonstrated differences are significant, and demonstrate that the invention compositions have unexpectedly and significantly better flexibility, smoothness and turbidity properties than comparative compositions according to standard testing methods. That is, the invention compositions were determined to be significantly better than comparative compositions using standard testing. Such evidence, by itself, is sufficient to demonstrate the unexpected benefits associated with the claimed compositions.

The unique combination of elements required by the present invention results in compositions having improved sensory and transparency characteristics. Compositions which do not contain either the required silicone with quaternary ammonium groups or the required liquid fatty alcohol do not possess such improved transparency and sensory characteristics. Clearly, the improved compositions of the present invention are neither taught nor suggested by the cited art.

For all of the above reasons, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

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Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Richard L. Treanor', is written over a horizontal line.

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